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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------|-------------|----------------------|---------------------|------------------|
| 10/596,803 | 06/23/2006 | John R. Cashman | HBRL002US | 1608 |
| 91963 | 7590 | 02/05/2010 | | |
| TechLaw LLP | | | EXAMINER | |
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| Suite 465 | | | | |
| San Diego, CA 92131 | | | ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|---------------------------------------|---|
| Office Action Summary | Application No. 10/596,803 | Applicant(s) CASHMAN, JOHN R. |
| | Examiner Patricia L. Morris | Art Unit 1625 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 November 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4-7,9-12,41,59,62,65,72-74 and 89 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,5,7,9-12 and 73 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,6,41,59,62,65,72,74 and 89 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-546)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Claims 1, 6, 41, 59, 62, 65, 72, 74 and 89 are under consideration in this application.

Claims 2, 4, 5, 7, 9-12 and 73 are held withdrawn from consideration as being drawn to non-elected subject matter 37 CFR 1.142(b).

Election/Restrictions

Applicant's election without traverse of Group III and compound no. 14 in Table 1 on page 43 of the specification in the reply filed on November 13, 2009 is acknowledged.

This application has been examined to extent readable on the elected compound, *i.e.*, 3-(1H-imidazol-5-yl) pyridine, exclusively. The search will not be extended because applicants are claiming a compound well known in the prior art. The prior art of record is just a sampling of the numerous prior art references.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 41, 59, 62, 65, 72, 74 and 89 are rejected under 35 U.S.C. 102(a), (b) and/or

(c) as being anticipated by Yamamoto (CA 35:38263 (1941), Heathcote et al. (CA 33:61044

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(1939), Bouchet et al. (US 6,353,108), Dolby et al. (US 7,183,305) and Kirchoff et al. (Organic Process Research & Development 2001, 5, 50-53).

Yamamoto, Heathcote et al. Bouchet et al., Dolby et al. and Kirchhoff et al. specifically recite the instant compound. Note RN 51746-85-1 in Yamamoto and Heathcote et al., example 1 of Bouchet et al., example 10 of Dolby et al. or compound 3 of Kirchhoff et al. Hence, the instant compound is deemed to be anticipated therefrom.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6, 41, 59, 62, 74 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Yamamoto, Heathcote et al., Bouchet et al., Dolby et al. and Kirchoff et al. in view of Imoto et al. (US 2003/0100769).

Yamamoto, Heathcote et al., Bouchert et al., Dolby et al. and Kirchoff et al. disclose the claimed compound. The anticipatory nature of the references have been clearly identified in the previous section and hereby incorporated by reference.

It is believed that one having ordinary skill in the art would have found the claimed compounds *prima facie* obvious, since they embraced by the disclosed formulas; *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See also *In re Malagari*, 499 F.2d 1297, 182 USPQ 549 (CCPA 1974); *In re Lemin*, 332 F.2d 839, 141 USPQ 814 (CCPA 1964); *In re Rosicky*, 276 F.2d 656, 125 USPQ 341 (CCPA 1960). Moreover, Imoto et al. teach that analogous compounds are known to have good affinity for nicotinic acetylcholine receptors. Accordingly, one having ordinary skill in the art would have been motivated to prepare the compound disclosed by the references which the expectation that they would show affinity for nicotinic acetylcholine receptors.

It is believed well settled that a reference may be relied upon for all that it would have reasonably conveyed to one having ordinary skill in the art. *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); *In re Lamberti*, 545 F.2d 747, 192 USPQ 278 (CCPA 1976); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Susi*, *supra*.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L. Morris/
Primary Examiner, Art Unit 1625

plm
February 1, 2010